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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,919	11/03/2003	Stephen Bowling	115345-00001	3897

7590 02/20/2007  
WILLKIE FARR & GALLAGHER LLP  
787 Seventh Avenue  
New York, NY 10019

EXAMINER
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MENDIRATTA, VISHU K

ART UNIT	PAPER NUMBER
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3711

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/20/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/699,919	<b>Applicant(s)</b> BOWLING, STEPHEN	
	<b>Examiner</b> Vishu K. Mendiratta	<b>Art Unit</b> 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 21-444 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

1. The amendment filed 10/21/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Spheres of different sizes in claim 25.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

2. Claim 27 provides for the use of visible figures sizes, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 27 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

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3. Claim 27 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: underlying structure/substrate for providing indicia. As best understood an indicia is a marking that requires structure/substrate to be placed on. It is not possible to practice a method without proper structure/environment.

***Claim Rejections - 35 USC § 102***

4. Claim 35 rejected under 35 U.S.C. 102(b) as being anticipated by Gohlke (5372366).

Claim 35: Gohlke teaches game spheres with number values 2 through 6 and game dice with number values 2 through 6. Dice can be used for indicating rules and comparing numbers.

Claim 36-40: Limitations are rules and not further limiting the apparatus in claims.

Claims 41-42: Gohlke teaches cards with numbers 2-6 (Fig.2a).

***Claim Rejections - 35 USC § 103***

5. Claims 21,43 rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobs (6581932).

Claims 21,43,44: Jacobs teaches a plurality of game pieces (knight game piece,18), at least one information indicator (battle card 20) having indicia indicating specific properties (weapon etc) associated with the game piece (note: picture of knight game piece on the indicator card 20), a random number generator (12,14,16), and a rule indicator (card of happiness or card of doom) .

(See 4:11-24) Move a fighter that is In Play five spaces if possible. Either the Card of Happiness or the Card of Doom will now determine the fighter's fate. Roll a single die to determine which card holds your fate. The number rolled represents the column on the card. Columns one through three appear on the

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Card of Happiness and columns four through six appear on the Card of Doom. Next roll two dice to determine the row underneath that column (represented by the sum of the two dice). Perform the fate that is displayed next to the row number. Refer to the fate descriptions in the Card of Happiness or Card of Doom sections. A player must be careful which fighter is chosen to move five spaces, because the player may be sending the fighter to its doom.

The above paragraph clearly indicates doom cards/happiness cards indicate rules relating number generator and game piece information.

Jacobs teaches all limitations except that it does not teach a game character within a sphere.

Applicant's disclosure in the beginning clearly admits use of spherical objects with figures/swirls within, in playing Chinese game boards.

Examiner takes the position that encapsulating game figures inside attractive shapes is a matter of aesthetical preference. Examiner also takes the position that encapsulated game pieces with figures inside spherical shapes are commonly known and sold by vending machines.

In order to make the game attractive to potential players, it would have been obvious to provide encapsulated game pieces in a game kit in various shapes.

Further the examiner takes the position that game pieces/figures/characters are likely to get soiled due to frequent touching by players.

Examiner takes the position that encapsulating game figures inside enveloping bodies is a matter of protecting game figures.

Examiner also takes the position that encapsulated game pieces with figures inside spherical shapes are commonly known and sold by vending machines.

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One of ordinary skill in art at the time the invention was made would have suggested encapsulating game figures/characters for providing aesthetics to attract potential players and for protecting the game pieces.

Note: The examiner further the position that limitation "rules specifying.....contact with each other." does not further limit the kit.

Claim 22: Jacobs teaches a die (12,14,16).

Claim 23: Jacobs teaches markers (Fig.2) for defining the playing field.

Claim 24: Markers having flat bases (2:50-52).

Claim 25: Jacobs does not teach providing spheres of different sizes. It is well known to provide game pieces in all shapes and sizes in battle/war/combat related games to distinguish one player piece from another. In order to distinguish game pieces it would have been obvious to provide in different sizes. One of ordinary skill in art at the time the invention was made would have suggested providing game pieces in different sizes to distinguish ownership by players.

Claim 26: Markers clearly teaches at least one battle card for each fighter game piece (2:1).

6. Claims 27,32 rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobs (6581932).

Claims 27: Jacobs teaches a plurality of game pieces (knight game piece, 18), at least one information indicator (battle card 20) having indicia indicating specific properties (weapon etc) associated with the game piece (note: picture of knight game

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piece on the indicator card 20), a random number generator (12,14,16), and a rule indicator (card of happiness or card of doom).

(See 4:11-24) Move a fighter that is In Play five spaces if possible. Either the Card of Happiness or the Card of Doom will now determine the fighter's fate. Roll a single die to determine which card holds your fate. The number rolled represents the column on the card. Columns one through three appear on the Card of Happiness and columns four through six appear on the Card of Doom. Next roll two dice to determine the row underneath that column (represented by the sum of the two dice). Perform the fate that is displayed next to the row number. Refer to the fate descriptions in the Card of Happiness or Card of Doom sections. A player must be careful which fighter is chosen to move five spaces, because the player may be sending the fighter to its doom. The previous paragraph clearly indicates doom cards/happiness cards indicate rules relating number generator and game piece information.

Jacobs teaches placing game pieces on a board with defined field (abstract).

Examiner takes the position that Jacobs teaches a battle game between game pieces and a battle between medieval game pieces is inherently understood as two game pieces coming physically in contact with each other.

Jacobs further teaches using a number generator together with indicia indicator (battle card) to resolve situation between two game pieces (20:9-13).

The above paragraph clearly indicates doom cards/happiness cards indicate rules relating number generator and game piece information.

Jacobs teaches all limitations except that it does not teach a game character within a sphere.

Applicant's disclosure in the beginning clearly admits use of spherical objects with figures/swirls within, in playing Chinese game boards.

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Examiner takes the position that encapsulating game figures inside attractive shapes is a matter of aesthetical preference. Examiner also takes the position that encapsulated game pieces with figures inside spherical shapes are commonly known and sold by vending machines.

In order to make the game attractive to potential players, it would have been obvious to provide encapsulated game pieces in a game kit in various shapes.

Further the examiner takes the position that game pieces/figures/characters are likely to get soiled due to frequent touching by players.

Examiner takes the position that encapsulating game figures inside enveloping bodies is a matter of protecting game figures.

Examiner also takes the position that encapsulated game pieces with figures inside spherical shapes are commonly known and sold by vending machines.

One of ordinary skill in art at the time the invention was made would have suggested encapsulating game figures/characters for providing aesthetics to attract potential players and for protecting the game pieces.

Claim 28: Jacobs teaches a die (12,14,16).

Claims 29,30: Jacobs teaches markers (Fig.2) for defining the playing field.

Claims 32,33: Note claim 30 of Jacobs clearly teaches determining outcome.

Claim 34: See 18:46-54 after battle game pieces are removed.

7. Claim 31 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishu K. Mendiratta whose telephone number is (571) 272-4426. The examiner can normally be reached on Mon-Fri 8AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to be 'VK' followed by a stylized flourish.

Vishu K Mendiratta  
Primary Examiner  
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VKM  
February 8, 2007